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10/801,112	03/16/2004	Yair Shachar	P-4678-US1	9190

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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT PAPER NUMBER

2643

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/801,112	<b>Applicant(s)</b> SHACHAR ET AL.	
	<b>Examiner</b> Melur Ramakrishnaiah	<b>Art Unit</b> 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-55,58-61 and 63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55,58-61 and 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-1-2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claims in the Application are not properly numbered. These are some of the problems with claim numbers. Applicant is required to correct them.

a) Two claims are numbered 51 on page 39.

b) Claim numbers jump from claim 55 to claim 58 and claim 61 to claim 63 on page 40.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-55, 58-61, 63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S.

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Patent No.6, 831,675. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the present application is an obvious variation of claim 1 of U.S. Patent No.6, 831,675.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7-9, 11-16, 18-19, 21, 24-30, 32-36, 37-41, 43-44, 45-47, 48-50, 53-55, 59-61, 63, are rejected under 35 U.S.C 102(e) as being anticipated by Cruickshank (US PAT: 6,704,294, filed 10-13-1999).

Regarding claim 1, Cruickshank discloses a method comprising: accepting information regarding an audio communication session among a set of audio communication terminals (110/120, fig. 1), wherein each of the subset of audio communication terminals is associated with a data collaboration terminal (112, fig. 1), and initiating a data collaboration session for an associated data collaboration terminal, using a audio communication terminal (col. 3, line 38 – col. 5, line 8).

Regarding claim 25, Cruickshank discloses a method comprising: receiving information regarding audio session among plurality of audio communication devices (112/120, fig. 1), for each of the audio communication device, determining which, if any, of a set of data collaboration terminals (112/122, fig. 1) are associated with the audio communication device, and initiating data collaboration session among the data communication terminals associated with the audio communication devices, using an audio communication terminal (col. 3, line 38 – col. 5, line 8).

Regarding claim 53, Cruickshank discloses a device comprising: a controller in (114, fig. 1) to accept information regarding an audio communication session among a set of audio communication terminals (110/120, fig. 1), wherein each of a subset of audio communication terminals is associated with a data collaboration terminal (112/122, fig. 1), using an audio communication terminal (col. 3, line 38 – col. 5, line 8).

Regarding claims 2-4, 7-9, 11-16, 18-19, 21, 26-30, 54-55, 59-61, 63, Cruickshank further teaches the following: step of initiating data collaboration session includes at least the step of sending a data collaboration request to the relevant data collaboration terminal (for example 122/510, figs. 1, 5), embedding a data collaboration request within a PSTN call (fig. 5, col. 6 lines 3-15), step of accepting information regarding an audio communication session includes at least accepting from a telephony network the addresses of the audio communication terminals, determining which of the set of audio communication terminals is registered in a database (118, figs. 1, 5), wherein data collaboration session is initiated if one of the audio communication terminals id registered in the database, comprising for each of the audio communication

terminals (for example 110/112 or 110/510, figs. 1, 5), cross referencing the address of the audio communication terminal with the address of a data collaboration terminal (col. 4 lines 10-26), audio communication session includes permission information (this is implicit in as much as the collaboration cannot take place unless both parties agree), telephony network includes a PBX (114, fig. 1), data collaboration terminals communicate via an IP network (518, fig. 5), audio information for data collaboration is transmitted by the audio communication session, data collaboration includes the step of alerting the auto answer mode of the relevant data collaboration terminal (col. 4, line 66 – col. 5, line 8), accepting a request for a data collaboration session (col. 4 lines 59-65), determining at least two of the set of audio communication terminals are reregistered in a database (col. 4 lines 10-24), set of audio communication terminals are connected by a private branch exchange (114, fig. 1), the information is sent from the audio communication terminal using Dual-Tone Multi-frequency (col. 5 lines 37-39), step of starting data collaboration session includes at least transmitting a data collaboration request to the data collaboration terminal, an audio communication session includes at least the address of the audio communication device, the information regarding an audio communication session includes a telephone number, determining if an audio communication device is registered in a database (118, fig. 1), and determining an address of an associated data collaboration terminal (col. 4 lines 11-36), controller in (114, fig. 1) is to accept from a telephony network the address of the set of audio communication terminals, the controller is to determine which of the set of the audio communication terminals is registered in a database (118, fig. 1), wherein data

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collaboration session is initiated if at least one of the audio communication terminals is registered in the database, the controller is to, for each of the audio communication terminals, cross reference the address of the audio communication terminal with the address of the data communication terminal, the audio information for data collaboration is transmitted by the audio communication session (col. 4 lines 11-36; col. 4, line 66 – col. 5, line 8).

Regarding claim 32, Cruickshank discloses a system comprising: an SMS server (reads on 610, fig. 6), server (reads on 114, fig. 6), an internet location server (reads on 614, fig. 6) in communication with the SMS server and the server, wherein the internet location server receives signals from the SMS server indicating that audio session is taking place among plurality of endpoints, the internet location server transmits a signal to a server, and the server, upon the receipt of the signal initiates a data collaboration session between plurality of end points (col. 6, line 27 – col. 8, line 2; col. 8 lines 47-51).

Regarding claim 45, Cruickshank discloses a method comprising: during an audio session between a plurality of users, receiving unique ID data from an audio communication terminal, initiating a data collaboration session by a user, using SMS, sending an SMS to an internet location server (reads on 614, fig. 6), sending an indication to an audio communication terminal to initiate a data collaboration session, and remotely activating a data a data collaboration session (col. 6, line 27 – col. 8, line 2; col. 8 lines 47-51).

Regarding claims 33-36, 37-41, 43-44, 46-50, Cruickshank further teaches the following: database (118, figs. 1, 6) including data collaboration session enabled end

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points (112/512, fig. 6), server (114, fig. 6) transmits data collaboration request to the data collaboration terminal, signals indicating that an audio session is taking place include at least the address of an audio communication terminal, signals indicating that an audio session is taking place includes at least a telephone number (col. 4 lines 11-36), server is a videoconference server (col. 5 lines 21-25), the endpoints include audio communication terminals which communicate via PBX (114, fig. 6), endpoints include data collaboration terminals (112/512, fig. 6) which communicate via an IP network, audio information for data collaboration session is transmitted by the audio session (col. 8 lines 47-51), audio information is transmitted by DTMF, initiating data collaboration session includes the step of alerting an answer mode of the relevant endpoints, audio communication detection accepts a user request for data collaboration session, initiating registration application, thereby associating user's data collaboration terminal and audio communication terminal, putting the audio session on hold (this is implied as the users have to wait for setting up data channel through internet) to initiate a communication session with an SMS server (reads on 610, fig. 6), terminating the communication session and liberating the audio session, determining if there is a correlation between the ID data contained in the SMS message and the data collaboration terminal associated with the ID data (figs. 9, 11), checking whether data collaboration terminals are on line and ready for the communication (col. 2 lines 43-56).

3. Claims 51/51 are rejected under 35 U.S.C 102(b) as being anticipated by Ahuja et al. (US PAT: 5,689,553, hereinafter Ahuja).



Regarding claim 51/51, Ahuja discloses a system comprising: a plurality of data collaboration terminals (fig. 1), each collaboration terminal including videoconferencing application software and a network interface, a voice gateway in (192, fig. 6), a PSTN switch, an audio conference bridge (210, fig. 6) and a multipoint control unit in (28, fig. 6) to enable initiation of data collaboration session between at least two data collaboration terminals (156/158, fig. 6), based on the information relating to the audio session (col. 10, line 34 – col. 12, line 6), directing a voice call to a voice gateway, and to PSTN switch, directing the voice call to an audio conference bridge (210, fig. 6), using DTMF signals, and initiating a video/data session between two or more users, by a multipoint conference unit in (28, fig. 6-9, col. 12, line 7 – col. 13, line 24).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cruickshank in view of Sullivan (US PAT: 5,351,296).

Regarding claims 5 and 22, Cruickshank does not teach the following: silencing the DTMF data collaboration request.

However, Sullivan discloses financial transmission system which teaches the following: Silencing DTMF signals during transaction (col. 3 lines 48-54).

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Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Cruickshank's system to provide for the following: silencing the DTMF data collaboration request as this arrangement would facilitate the user to avoid damage and discomfort to the listener's ear during transaction as taught by Sullivan.

6. Claims 6, 23, 31, 42, 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cruickshank in view of Fostick (US PAT: 6,856,809, filed 5-17-2001).

Cruickshank differs from claims 6, 23, 31, 42 and 58 in that although he teaches implementing a data collaboration request using telephone call (see abstract); but does not teach the following: implementing a data collaboration request using SMS and transmitting audio information by SMS.

However, Fostick discloses SMS conference system which teaches the following: implementing a data collaboration request (reads on conferencing) using SMS and transmitting audio information by SMS (fig. 6, and see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Cruickshank's system to provide for the following: implementing a data collaboration request using SMS and transmitting audio information by SMS as this arrangement would provide one of the methods, among many possible methods, for initiating collaboration request as shown by Fostick.

7. Claims 10, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cruickshank in view of Kerr (US PAT: 5,844,600).

Regarding claims 10 and 20, Cruickshank does not teach the following: inserting delay in audio communication session.

However, Kerr discloses methods and apparatus and systems for transporting multimedia conference data streams through a transport network which teaches the following: inserting delay in audio communication session (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Cruickshank's system to provide for the following: inserting delay in audio communication session as this arrangement would facilitate synchronizing information to suite application needs as taught by Kerr.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cruickshank in view of Hinderks (US PAT: 6,700,958, filed 7-3-2001, hereinafter Hinderks).

Regarding claim 17, Cruickshank does not teach the following: audio data sent from the audio communication terminals is compressed with wide band audio.

However, Hinderks discloses method and apparatus for transmitting coded audio signals which teaches the following: audio data sent from the audio communication terminals is compressed with wide band audio (fig. 1, col. 3 lines 31-51).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Cruickshank's system to provide for the following: audio data sent from the audio communication terminals is compressed with wide band audio as this arrangement would facilitate wide band audio which can be transmitted within the available bandwidth as taught by Hinderks.

9. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja in view of Sullivan.

Regarding claim 52, Ahuja does not teach the following: silencing the DTMF signals.

However, Sullivan teaches the following: silencing the DTMF signals (col. 3 lines 48-54).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ahuja's system to provide for the following: silencing the DTMF signals as this arrangement would facilitate the user to avoid damage and discomfort to the listener's ear during transaction as taught by Sullivan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Melur Ramakrishnaiah  
Primary Examiner  
Art Unit 2643